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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,584

03/29/2005

Claes Persson

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EXAMINER

GRANO, ERNESTO ARTURIO

ART UNIT

PAPER NUMBER

3728

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,584	<b>Applicant(s)</b> PERSSON, CLAES	
	<b>Examiner</b> ERNESTO A. GRANO	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/29/2005, 05/03/2006</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. (see page 2, line 20, NO Patent App. 19974021)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, The distance between the first and the second sheet and the dimension of the sheets in claim 1 are defined with reference to a card which is not part of the claimed subject-matter. As cards comprising a data-carrying element exist in different dimensions and the data-carrying element can have various shapes and

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positions on the card (e.g. a chip on a SD card), the form of the device of claim 1 is unclear.

Defining the size of the claimed invention by the object to be held, without positively reciting the object to be held, renders the claim indefinite since it relies upon a variable object. A claim may be rendered indefinite by reference to an object that is variable. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd.Pat. App. & Inter. 1989).

Claims 2-20 depend from claim 1 and are rejected for the above reasons.

Regarding claims 1, 3, and 5, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-11, 18, and 19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wen Chi HU (FR 2,638,619).

In re claims 1, 6, and 7, with reference to figure 3, Wen Chi Hu ('619) discloses a device capable of storing and protecting a card (2), in the form of a holder (1) comprising shielding sheets (1) so arranged that they can envelop a data-carrying element (21), sheets of the holder (1) are produced from one uniform piece of sheet material (see figure 3) that is bent or folded so that the holder (1) has the form of a first sheet portion (1), and a second, parallel sheet portion (1) connected to the first sheet portion (1) via the fold (11), and wherein the first sheet portion (1) in terms of area is dimensioned so that it is essentially capable of completely overlapping the whole surface area of a card (2), depending on its size, and the second sheet portion (11) in terms of area is dimensioned so that it is capable of completely overlapping the data-carrying element (21), depending on its size, which can be in the form of a magnetic strip and/or a chip, integrated circuit, arranged on or in the card (2), if a card is fully inserted into the holder (1) (see figure 3)

However, Wen Chi Hu ('619) fails to expressly disclose a metal shielding sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a metal as the rigid shielding sheet, since metal was a known material and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Thus, it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was available,

including transformer sheet (e.g. "Electrical Steel"). Note, applicant admits that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel. (see page 4, lines 24-25)

In re claims 4, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 1 above, discloses wherein the holder is equipped with a suitable cleaning layer on the inside of the sides.

In re claim 5, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 1 above, discloses wherein the cleaning layer is made of a suitable relatively soft rubber material, felt material or the like.

In re claims 8, 9, and 11 with reference to figure 3, Wen Chi Hu ('619) as applied to claim 1 above, discloses the claimed invention except for the claimed thickness.

It has been held that, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

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In re claim 10 with reference to figure 3, Wen Chi Hu ('619) as applied to claim 1 above, discloses wherein a card that can be stored in the device can be one of a credit card, bank card, cash card, membership card, and keycard, depending on its size. (see figure 3)

In re claims 18, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 4 above, discloses wherein the shielding metal is selected from the material class "Electrical Steel".

In re claims 19, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 5 above, discloses wherein the shielding metal is selected from the material class "Electrical Steel".

4. Claims 2, 12, 14, 16, and 20 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Wen Chi Hu (FR 2,638,619) as applied to claim 1 above, in view of Littman (US Patent 3,027,995).

In re claim 2, with reference to figure 3, Wen Chi Hu (619) as applied to claim 1 above, discloses the claimed invention except for wherein that the holder on its external plane sides has applied thereto a layer or coating.

However, Littman ('995) teaches a combination money clip and article holder which is formed by a single sheet of metal that can be chrome plated or plated with other ornamental metal. (see column 2, lines 4-6)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the external plane side of Wen Chi Hu ('619) as applied to claim 1 above, with chrome or another ornamental metal as taught by Littman ('995) in order to give the holder a more appealing look.

In re claim 12, with reference to figure 1, Littman ('995) discloses wherein the coating is commonly known to be a wear-resistant material. (see column 2, lines 4-6)

In re claims 14, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 2 above, discloses wherein the holder is equipped with a suitable cleaning layer on the inside of the sides.

In re claims 16, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 2 above, discloses wherein the shielding metal is selected from the material class "Electrical Steel".

In re claim 20 with reference to figure 3, Wen Chi Hu ('619) as applied to claim 2 above, discloses the claimed invention except for wherein the shielding metal has a thickness in the range of 0.25 - 1.0 mm.



It has been held that, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

5. Claims 3, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wen Chi Hu (FR 2,638,619) and Littman (US Patent 3,027,995) as applied to claim 2 above, and in further view Parker (US Patent 4,792,058).

In re claim 3, Wen Chi Hu ('619) and Littman ('995) as applied to claim 2 above, discloses the claimed invention except for wherein the layer is provided with distinctive marks in the form of a logo, advertising or other decoration.

However, Parker ('058) teaches a pocket-sized dispenser for business or calling cards which includes a case having generally continuous upper and lower surfaces upon which advertising or identification indicia may be displayed and in which the cards are protectively housed for selective dispensing utilizing a reinforced and automatically retracted ejector mechanism. (see abstract)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the external plane side layer of Littman ('995) as applied to claim 2 above, with advertising or identification indicia as taught by

Parker ('058) in order to be used by corporations and/ or businesses as effective promotional sources or materials. (see column 5. lines 59-66)

In re claims 15, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 3 above, discloses wherein the holder is equipped with a suitable cleaning layer on the inside of the sides.

In re claims 17, with reference to figure 3, Wen Chi Hu ('619) as applied to claim 3 above, discloses wherein the shielding metal is selected from the material class "Electrical Steel".

6. Claim 13, as best understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Wen Chi Hu (FR 2,638,619) and Littman (US Patent 3,027,995) as applied to claim 12 above, in further view of Kamens et al. (US Patent 5,941,375).

In re claim 13, Wen Chi Hu ('619) and Littman ('995) as applied to claim 12 above, discloses the claimed invention except for wherein the coating is one of an elastomer and a suitable plastic material.

However, Kamens et al. ('375) teaches a protective card case comprising a plastic covered magnetic shielding metal for holding a card having a magnetically encoded strip. (see column 4, lines 59-67 and column 5, lines 1-4)

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the cover layer of Wen Chi Hu ('619) and Littman ('995) as applied to claim 12 above, with a plastic coating as taught by Kamens et al. ('375) in order to have a appealing case that can come in a variety of different plastic colors.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERNESTO A. GRANO whose telephone number is (571)270-3927. The examiner can normally be reached on 7:00am - 4:00pm Mon.-Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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AU 3728

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